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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,299	05/24/2001	Toyonori Sasaki	103007.01	9529

25944 7590 04/12/2002

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EXAMINER
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NGHIEM, MICHAEL P

ART UNIT	PAPER NUMBER
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2861

DATE MAILED: 04/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/863,299

Applicant(s)

SASAKI, TOYONORI

Examiner

Michael P Nghiem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 46-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 46-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/280,056.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

The Amendment filed February 6, 2002 has been acknowledged.

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 46-68 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,270,207 (Sasaki) in view of US Patent No. 5,877,794 (Takagi). Sasaki claimed all the features of the invention with the exception of the transparent or semi-transparent side wall with undulating ribs extending vertically up and down. However, Takagi discloses the transparent or semi-transparent side wall (Fig. 7) with undulating ribs (42) extending vertically up and down (Fig. 8) for the purposes of detecting ink and suppressing the vibration of ink.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 56-61 and 66-68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 56-61, "the first chamber" and "the second chamber" throughout the claims lack antecedent basis. Which ones?

Claim 61, are the first and second covers different from the first and second covers of claim 59?

Claim 66, the phrase "... the path and the first chamber are connected via a portion of a surface which does not contain an intersection line formed by the intersection of a surface and a surface" is unclear.

The remaining claims are also rejected under 35 U.S.C. 112, second paragraph, for being dependent upon a rejected base claim.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 46, and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Shinada et al. (US 5,790,158).

Shinada et al. discloses the all the limitations of the invention:

- an ink cartridge (Figs. 15a, 15b) for holding ink, comprising:
  - a case (casing of 501) having a first surface (top surface of 501) on the outside of the case (Figs. 15a, 15b) and a second surface (bottom surface of 501) on the outside of the case in mutual opposition (Figs. 15a, 15b), the first surface being open (with lid 516 removed);
  - a first cover (516) for covering the first surface;
  - a partitioning wall (510) for separating the interior of the case into a first chamber (511) and a second chamber (512), respectively, for holding the ink;
  - a porous material (520) accommodated in the first chamber (Figs. 15a, 15b);

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- an ink filling hole (515) formed in the first cover for filling the first chamber and the second chamber with ink (Fig. 15a); and

- a pressure reduction hole (514) formed in the first cover for reducing the pressure in the first chamber and the second chamber (Fig. 15a, column 16, lines 10-12), wherein the first chamber and the second chamber are connected near the second surface inside the case (via 519, Fig. 15a);

- an ink discharge hole (513) for discharging ink from the first chamber or the second chamber is formed in the second surface of the case (Figs. 15a, 15b);

- the second surface is also open (without bottom cover of 501), a second cover (bottom cover of 501) is provided for covering the second surface, and the ink discharge hole is formed in the second cover (513 is formed in the bottom cover, Fig. 15a).

Claim 49 is rejected under 35 U.S.C. 102(b) as being anticipated by Shinada et al. ('158).

Shinada et al. discloses the all the limitations of the invention as discussed above with the exception that the second sealing material can be peeled away.

However, it has been held that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all

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the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Claims 56 and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Shinada et al. ('158).

Shinada et al. discloses the all the limitations of the invention:

- an ink cartridge (Figs. 15a, 15b) for holding ink supplied to a recording head, comprising:

- a cartridge case (casing of 501) having a first side wall (left side wall of 501, Fig. 15a) and a second side wall (right side wall of 501, Fig. 15a) opposed to the first side wall;

- a first partitioning wall (510 of 504) positioned substantially parallel to the first side wall (Fig. 15a) of the case so as to separate the interior of the cartridge case into a first chamber (511 of 504) and a second chamber (512 of 504) for respectively accommodating ink (Fig. 15a);

- a second partitioning wall (510 of 505) positioned substantially parallel to the first side wall (Figs. 15a, 15b) of the case for separating the interior of the case into a first chamber (512 of 505) and an atmosphere connection path (511 of 505) for communicating with an atmosphere outside the case, wherein one end of the second chamber communicates with one end of the first chamber (via 519 of 504), one end of the atmosphere connection path communicates with the other end of the first chamber

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(519 of 505) and the other end of the atmosphere connection path is open to the outside of the case (via 515 of 505);

- the atmosphere connection path is divided between the first side wall and the second partitioning wall (Fig. 15a), and the second chamber (512 of 504) is divided between the second side wall and the first partitioning wall (Fig. 15a).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 62-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinada et al. in view of Takagi (US 5,877,794).

Shinada et al. discloses the claimed limitations as discussed above.

However, Shinada et al. does not disclose that at least one portion of the one side wall is transparent or semi-transparent, wherein an inner surface of the transparent or semi-transparent part of the one side wall has undulating ribs extending vertically up and down.



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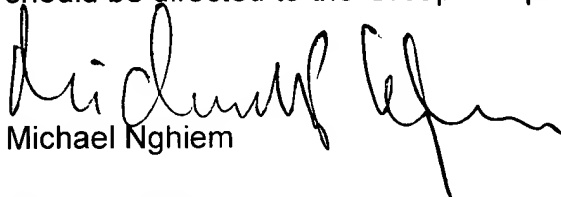
Nevertheless, Takagi discloses that at least one portion of the one side wall is transparent or semi-transparent (Fig. 7) for the purpose of detecting ink, wherein an inner surface of the transparent or semi-transparent part of the one side wall has undulating ribs (42) extending vertically up and down (Fig. 8) for the purpose of suppressing the vibration of ink.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Shinada et al. with the side wall and ribs as disclosed by Takagi for the purposes of detecting ink and suppressing the vibration of ink.

### ***Response to Arguments***

5. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Nghiem whose telephone number is (703) 306-3445. An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 308-0956.

  
Michael Nghiem

April 11, 2002